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09/463,096

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HANS TANDLER

GK-ZEI-3078

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09/08/2004

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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EXAMINER

FINEMAN, LEE A

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | | |
|------------------------------|-------------------------------|--|--------------------------------|--|
| Office Action Summary | Application No. 09/463,096 | | Applicant(s) TANDLER ET AL. | |
| | Examiner Lee Fineman | | Art Unit 2872 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15, 17-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15, 17-23 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/1/00 & 9/11/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office Action is in response to an amendment filed 3 June 2004 in which claim 25 was added. Claims 13-15, 17-23 and 25 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-15, 17-21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant application which is admitted prior art (Admission) in view of Nagashima et al., U.S. Patent No. 5,742,735 and Sarfaty et al., U.S. Patent No. 5,741,171.

Regarding claims 13, 17, 23 and 25, Admission discloses a stereomicroscope with a zoom system (fig. 1) comprising a drive motor (M) driving at least one moving lens system (L1 or L2), which is a pair of movable lenses for stereo imaging and operable to move in a non-parallel manner with respect to each other. Admission lacks linear direct driving motors being controlled by a control unit which reads from a memory calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system by controlling the driving motors in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve; and the control unit being used for motorized zoom adjustments and motorized focusing of the microscope. Nagashima et al. teaches a zoom

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system with a driving means (9 and 10) being controlled by a control unit (6) which reads from a memory (column 2, lines 55-56) calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of the at least one moving lens system (2 or 3) by controlling the driving means in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve (column 3, lines 13-24) and the control unit being used for motorized zoom adjustment and for motorized focusing (column 3, lines 13-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the drive unit of Admission with a drive unit of Nagashima et al. to be able to maintain an in-focus image during zooming (column 2, lines 6-9; Nagashima).

Nagashima et al. discloses driving means to linearly move the lens groups. This arrangement appears to be direct linear drive motors. However in as much as direct linear drive motors are not explicitly disclosed, use of such motors are well known in the art for zoom systems. For example, Sarfaty et al. teaches a video microscope and video imager with zooming (column 2, lines 60-64) wherein direct linear driving motors are used (stepper motors, column 9, lines 35-36). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well known direct linear drive motors to provide precise linear movement of the lens groups.

Regarding claim 15 and 20, Admission in view of Nagashima et al. discloses lens members that comprise at least one moving lens system (L1 or L2) and are provided as lens pairs in a Greenough type stereomicroscope or telescope type stereomicroscope (Admission, fig 1) and plurality of moving lens members (L1 and L2) that comprise of at least one moving lens system and are controlled jointly (Admission, fig. 1).

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Regarding claims 18 and 19, Admission in view of Nagashima et al. discloses the claimed invention but is silent to the linear drives being arranged in the stereomicroscope housing and between the lens pairs. Official Notice is taken that having linear drives being arranged in a device housing is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear drives of Admission in view of Nagashima et al. be arranged in the stereomicroscope housing in order to protect against foreign particles, etc. which would interfere with the operation of the motors. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the driving motors of Admission in view of Nagashima et al. to be between the lens pairs, since it has been held that a mere rearrangement of an element without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the driving motors to be between the lens pairs again for the purpose of making the overall device more compact. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Regarding claims 14 and 21, Admission further discloses two lens members (L1 and L2) that comprise at least one moving lens system (fig. 1). Admission discloses the claimed invention except for the two lens members being controlled independently from one another and driven separately. Nagashima teaches a zoom system wherein two lens members (2 and 3) are being controlled independently from one another and driven separately (through 9 and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make each of the lens members of

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Admission be controlled and driven separately, as suggested by Nagashima to be able to maintain an in-focus image during zooming (column 2, lines 6-9; Nagashima).

3. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Nagashima et al. and Sarfaty et al. as applied to claim 13 above, and further in view of Pensel et al, U.S. Patent No. 5,867,308.

Admission in view of Nagashima et al. and Sarfaty et al. discloses the claimed invention except for a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system. Pensel et al. teaches a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system (12, fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear magnification of Admission in view of Nagashima et al. and Sarfaty et al. that is adjusted be determined and displayed as Pensel et al. suggests in order to arrive at a desired magnification with ease.

Response to Arguments

4. Applicant's arguments filed 3 June 2004 have been fully considered but they are not persuasive.

Applicant argues that the drive motors of Nagashima et al. cannot replace the drive unit of the Admitted Prior Art because the drive unit of Nagashima moves lenses that are in the same axis and move in parallel with each other along the same axis (page 5, lines 14-20) while the Admitted Prior art has a pair of lenses on different axis and the two axes are not parallel to each other. The examiner respectfully disagrees. While the

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lenses may be move differently, i.e. on one axis or two because of the lens holders, the drive unit of the both the Admitted Prior Art and Nagashima move on a single axis to drive the lenses based a curve (see dashed line F2 in fig. 1 of the instant application and fig. 1 of Nagashima). Therefore the drive unit of Nagashima is appropriate for combination with the Admitted Prior Art and would provide the correct movement, i.e. along a single axis F2 and make the lens pair move on non-parallel axis, and the rejection is proper.

5. As stated in the prior office action the official notice statement of the examiner about housings are held to be admitted prior art.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313.

The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF
August 23, 2004



MARK A. ROBINSON
PRIMARY EXAMINER